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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/582,445

09/25/2006

Yu Sing Hooi

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Ballard Spahr LLP

SUITE 1000

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ATLANTA, GA 30309-3915

EXAMINER

REICHLE, KARIN M

ART UNIT

PAPER NUMBER

3761

MAIL DATE

DELIVERY MODE

06/25/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,445	Applicant(s) HOOI, YU SING	
	Examiner Karin M. Reichle	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 12-15 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 12-15 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/20/10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5-20-10 has been entered.

Specification

Drawings

2. The drawings were received on 5-20-10. These drawings are approved. However see the following paragraph.

3. The drawings are objected to because the numbering of page 2 is different than that of pages 1 and 3, i.e. 2-3 as compared to 1/3 and 3/3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement

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sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Description

4. The disclosure is objected to because of the following informalities: 1) The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims are not commensurate in scope, see MPEP 608.01(d), where is the invention as set forth at page 4, line 13 now claimed?

Appropriate correction is required.

Claim Language Interpretation

5. The claim terminology is interpreted in light of the definitions on page 4, line 25-page 5, line 1 (It is noted that such does not require wearing entirely inside or outside) and page 8, lines 18-20. Any other claim language not specifically defined has been interpreted in view of the usual and common meaning of such, e.g. the dictionary definition.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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7. Claims 1-3, 7-8, 10, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lloyd EP '039 in view of Wilson III, '779.

Claim 1: See Claim Language Interpretation section supra, hereinafter also referred to as CLI, and '039 at the Figures, esp. 1-4B, page 27, line 8-page 31, last line, page 4, lines 3-11, page 15, lines 16-27, page 10, lines 15-20, the paragraph bridging pages 14-15, page 15, first full paragraph, page 16, lines 1-17, page 17, lines 1-6 and 14-22, page 18, line 1-page 19, line 14, page 20, line 1-page 21, line 9, and page 22, line 19-page 24, last line, i.e. '039 teaches a sanitary product for insertion into a human vagina which includes an internally worn absorbent plug, e.g., at least a portion of 11, and an externally worn absorbent pad, e.g. 6, joined to one another by a sheath 2, 3 that opens through the pad, see, e.g., Figures, esp. 2A and/or page 21, lines 5-9, such that a wearer's finger can be received in the sheath to assist insertion, see, e.g., page 15, lines 1-7 and 11-15 or page 29, lines 13-16. Claim 1 now also requires the sheath be elastic in only a circumferential direction which allows for radial expansion. While '039 at, e.g., the paragraph bridging pages 14-15, the first full paragraph on page 15, page 16, lines 8-10 and page 17, lines 13-17 teaches the sheath of various flexible, e.g., resilient, knit or elastic materials, and capable of expansion diametrically/circumferentially/in a radial direction to receive a finger, i.e. a body part, for digital insertion of the product into the vagina, it does not explicitly disclose the sheath is elastic in only a circumferential direction, i.e. is capable of expansion and retraction in only the circumferential direction. However, see '779 at the abstract, the Figures, col. 1, lines 8-13, 43-46, col. 5, lines 10-19, the Summary of the Invention section, col. 7, lines 38-col. 8, line 3, col. 10, lines 20-32, col. 12, lines 28-43 the paragraph bridging cols. 14-15, the claims, esp. note the preambles, i.e. teaches not only a sheath of various flexible, e.g., resilient, knit or elastic,

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materials which is capable of expansion diametrically/circumferentially/in a radial direction to receive a body part, but also which is elastic in only a circumferential direction, i.e. is capable of expansion and retraction in only the circumferential direction, in order to enhance retention.

Therefore, to make the sheath capable of expansion diametrically/circumferentially/in a radial direction to receive a finger, i.e. a body part, of '039 a sheath elastic in only a circumferential direction which allows for radial expansion instead, if not already, would either be obvious, see *In re Siebentritt*, 54 CCPA 1083, i.e. two equivalents are interchangeable for the desired function, express suggestion of desirability not needed to render such substitution obvious, i.e. here the equivalents are interchangeable for the desired function of providing expansion diametrically/circumferentially/in a radial direction to receive a body part, i.e. finger, and/or would be obvious to one of ordinary skill in the art in view of the teachings of '779 due to the recognition that such would not only provide a sheath capable of expansion diametrically/circumferentially/in a radial direction to receive a finger but also provide retention thereon which would enhance the efficacy of digital insertion and the desire of such expansion and insertion by '039.

Claim 2: See, e.g., page 17, lines 1-6 and page 19, lines 1-11, i.e. the sheath is liquid impermeable in a direction from the outside of the sheath to the inside of the sheath.

Claim 3: See discussion of claims 1-2, i.e. the sheath comprises tube of liquid impermeable material.

Claim 7: See page 20, lines 7-8 and page 24, lines 12-15, i.e. the sheath comprises a tube of absorbent material.

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Claim 8: See overlapping tubular portions of 12, in Figures 1-1A, 2-2A, 3-3A, 4-4B, page 17, lines 1-6, page 18, lines 12-17, page 20, lines 3-8, page 24, last paragraph, i.e. the sheath comprises a tube of liquid impermeable material inside a tube of absorbent material.

Claim 10: See Figure 2B adjacent the arrow from 2 or page 24, last paragraph, i.e. the sheath has a smaller diameter than that of the plug.

Claim 12: See Figure 1B and page 15, lines 16-27, i.e. the sheath extends for substantially 2.5 cm between an end of the plug and a surface of the pad closest to the plug with “sufficient specificity”, see MPEP 2131.03.

Claims 13-14: See Figures, i.e. the product further comprises a cord 7 attached to the plug to assist removal of the plug from the vagina which cord extends along the inside of the sheath.

8. Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaysersberg ‘405 in view of Wilson III, ‘779

Claim 1: See Claim Language Interpretation section supra, hereinafter also referred to as CLI, and ‘405 at the Figures, esp. 3-4 and 6, the English abstract, see the full English translation, esp. the translation at page 16, second full paragraph, page 10, first full paragraph, page 16, third full paragraph, page 14, second full paragraph and the paragraph bridging pages 14, i.e. ‘405 teaches a sanitary product for insertion into a human vagina which includes an internally worn absorbent plug, e.g., at least a portion of 44, 444, and an externally worn absorbent pad, e.g. 2, joined to one another by a sheath 66 that opens through the pad, see, e.g., Figures, such that a wearer's finger can be received in the sheath to assist insertion, see, e.g., the second full paragraph on page 16. Claim 1 now also requires the sheath be elastic in only a circumferential direction which allows for radial expansion. While ‘405 at, e.g., page 13, second and third full

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paragraphs and the paragraph bridging pages 13-14 teaches the sheath includes an elastic, deformable or equivalent means capable of receiving a finger, i.e. a body part, for digital insertion of the product into the vagina, it does not explicitly disclose the sheath is elastic in only a circumferential direction, i.e. is capable of expansion and retraction in only the circumferential direction. However, see ‘779 at the abstract, the Figures, col. 1, lines 8-13 and 43-46, col. 5, lines 10-19, the Summary of the Invention section, col. 7, lines 38-col. 8, line 3, col. 10, lines 20-32, col. 12, lines 28-43, the paragraph bridging cols. 14-15, the claims, esp. note the preambles, i.e. teaches not only a sheath which has an elastic, deformable or equivalent means capable of receiving a body part but such means being elastic in only a circumferential direction, i.e. capable of expansion and retraction in only the circumferential direction, in order to enhance retention. Therefore to make the elastic, deformable or equivalent means of ‘405 an elastic/deformable structure as taught by ‘779, if not already, would either be obvious, see In re Siebentritt, 54 CCPA 1083, i.e. two equivalents are interchangeable for the desired function, express suggestion of desirability not needed to render such substitution obvious, i.e. here the equivalents are interchangeable for the desired function of providing deformable/elastic means to receive a body part, i.e. finger, and/or would be obvious to one of ordinary skill in the art in view of the teachings of ‘779 due to the recognition that such would not only provide a sheath/means thereof capable of expansion diametrically/circumferentially/in a radial direction to receive a finger but also providing retention thereon which would enhance the efficacy of digital insertion and the desire of such expansion and insertion by ‘405.

Claim 3: See cited portions in discussion of claim 1, i.e. the sheath 66 comprises a tube of liquid impermeable material.

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Claims 4-5: See cited portions in discussion of claim 1, i.e. the pad 2 comprises an absorbent layer 7 and a liquid impermeable backing sheet 99 and the backing sheet is integral with the liquid impermeable material of the sheath, see Figure 3.

Claim 6: The sheath passes liquid along its length from the plug to the pad, see English abstract.

9. Claims 15 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable Lloyd EP '039 and Wilson III, '779 as applied to claim 1 supra, and further in view of Phelps '234, and Denkinger '372.

Claims 15 and 19-20: See the paragraph bridging pages 14-15 and MPEP 2131.03, i.e. the diameter of the plug is 2 cm or less, 1.5 cm or less or 1.5 cm, respectively, with "sufficient specificity". Note also page 12, lines 7-9 of the instant specification. These claims further require the plug be substantially 4 cm in length or less, substantially 3.5 cm in length or less or substantially 3.5 cm in length, respectively. While '039 suggests such lengths, e.g. see page 15, lines 24-27 and the Figures, '039 does not explicitly teach such. However, note page 12, lines 7-11 of the instant specification, as well as '234 at col. 2, lines 55-58 and '372 at col. 1, lines 64-65 and col. 3, lines 12-15, i.e. the prior art desires the same properties/combination of properties as the instant application, i.e. a portion which is absorbent and sized for wear internally in the vagina as well as length/size being a result effective variable or specific sizes within the claimed ranges. Note also MPEP 2141.05. Therefore, even if the prior art does not include the exact length, the general conditions of the claim are disclosed thereby and it is not inventive, i.e. it would be obvious to one of ordinary skill in the art, to discover the optimum or workable ranges, i.e. Applicant's ranges, by routine experimentation, In re Aller, 105 USPQ 233 (CCPA 1955).

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10. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over are rejected under 35 U.S.C. 103(a) over Kaysersberg '405 and Wilson III, '779 as applied to claim 1 supra, and further in view of Ohba PCT'611 and Denkinger '372.

Claim 21: This claim requires an external portion, i.e. pad, have the shape of a flat ellipse with one end wider than the other. While page 11, lines 25-26 of '405 teach the external absorbent portion may be rectangular, oblong, sandglass or other shape it does not teach the claimed specific shape. However, see '611 at page 6, lines 10-13 and Figures 3-7 of '372, esp. Figure 7, i.e. interchangeability of shapes of external absorbent portions similar to '405 for those claimed, i.e. ellipsis with different sized ends. To make the shape of '405 the claimed shape instead would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by '611 and '372.

Claims 22-23: These claims require the pad be substantially 6.5cm long and 5.5cm wide or substantially 0.5cm thick, respectively, which '405 does not teach. However, see '611 at page 6, lines 18-30 and '372 at col. 3, lines 12-18 as well as page 13, lines 7-13 of the instant specification, i.e. the prior art desires the same properties/combination of properties as the instant application, i.e. a portion which is absorbent and sized for comfortable wear externally as well as length/width/caliper/size being result effective variables and/or specific sizes within the claimed ranges. Note also MPEP 2141.05. Therefore, at the very least the general conditions of the claim are disclosed thereby and it is not inventive, i.e. it would be obvious to one of ordinary skill in the art, to discover the optimum or workable ranges, i.e. Applicant's ranges, by routine experimentation, *In re Aller*, 105 USPQ 233 (CCPA 1955).

Double Patenting

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1-8, 10, 12-15, and 19-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 11/920481. Although the conflicting claims are not identical, they are not patentably distinct from each other. Since there was no administrative delay, the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the other application claims? The answer is yes. Claim 1 of the instant application is broader with regard to some aspects and narrower with regard to other aspects of the claims of the other application. With regard to the broader aspects (e.g. the instant application does not require a line of weakness, see claim 1 in the other application), once an applicant has received a patent for a species or more specific embodiment, he is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader, i.e. the patented claim anticipates the application claim. See In re Goodman, supra. With regard to the narrower aspects (e.g. the instant application claim 1 requires a sheath which is elastic in only a circumferential direction which allows for radial expansion), note claims, e.g., 18 and 17 in the other application as originally filed and as now amended. To make a sheath as claimed in the other application, e.g., claim 18, which is capable of receiving a finger also resiliently expandable in a radial direction as claimed in claim 17 of the other application would be obvious to one of ordinary skill in the art in view of the recognition that such provides the sheath with the capability of receiving a finger as desired.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

13. Applicant's remarks have been carefully considered but are deemed either moot in that the issue discussed has not been reraised or not persuasive for the reasons discussed supra.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Karin M. Reichle/
Primary Examiner, Art Unit 3761

June 17, 2010

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